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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,537	04/30/2001	Mark E. Molander	RSW920010012US1	3398

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EXAMINER

PESIN, BORIS M

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/845,537

### Applicant(s)

MOLANDER, MARK E.

### Examiner

Boris Pesin

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-17 and 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

This communication is responsive to Amendment filed 06/14/2004.

Claims 1-5, 7-17, 19-26 are pending in this application. Claims 1, 9, 13, and 21-26 are independent claims. In the Amendment filed 06/14/2004, Claims 1, 9, and 13 were amended. This action is made Final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-17, 19-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Google (Google Toolbar).

In regards to claim 1, Google teaches a method of providing secondary functions from a menu item graphical control, said method comprising: including a plurality of graphical components with the menu item graphical control, each of the graphical components corresponding to a different programmed function (Page 1, Google Toolbar, Elements 2 and 3), wherein the menu item graphical control includes a default

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area in addition to the plurality of graphical components (Page 1, Google Toolbar, Element 1); displaying the menu item graphical control with the included graphical components and the default area, wherein each of the graphical components are displayed in a position horizontal to the default area (Page 1, Google Toolbar, Elements 1, 2, and 3); receiving a selection from a user corresponding to the menu item graphical control (Page 1, Google Toolbar, "Highlight: Highlight your search terms as they appear on the page, each word in its own color"); invoking a default function in response to the selection corresponding to the default area of the menu item graphical control (Page 1, Google Toolbar, "Google Search: Access Google's search technology from any web page"); and in response to the selection corresponding to one of the graphical components, invoking the programmed function corresponding to the selected graphical component (Page 1, Google Toolbar, "Highlight: Highlight your search terms as they appear on the page, each word in its own color").

In regards to claim 2, Google teaches a method as described in claim 1 further comprising: displaying a sub-menu of selectable programmed functions in response to the user selecting a sub-menu graphical component (Page 2, Google Toolbar, "Page Info Menu: Gives you access to more information about the page that you are viewing. From this menu, you can choose three options").

In regards to claim 3, Google teaches a method as described in claim 1 wherein at least one of the graphical components includes a graphical icon that is displayed on the menu item graphical control (Page 1, Google Toolbar, Elements 1, 2, and 3).

In regards to claim 4, Google teaches a method as described in claim 1 further comprising: configuring the plurality of programmed functions using a configuration tool; modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions; and saving the configured plurality of programmed functions and the modified menu item graphical control (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box.").

In regards to claim 5, Google teaches a method as described in claim 1 further comprising: configuring one or more secondary functions to include in a sub-menu; modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu; saving the secondary functions and the modified menu item (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box.").

In regards to claim 7, Google teaches a method as described in claim 1 wherein the programmed functions include one or more application programs (Page 5, Google Toolbar, Element 1).

In regards to claim 8, Google teaches a method as described in claim 1 wherein the programmed functions include one or more application functions corresponding to an application program and wherein the menu item graphical control corresponds to the application program (Page 1, Google Toolbar, Elements 1, 2, and 3).

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Claim 9 is in the same context as claim 1; therefore it is rejected under similar rationale.

Claim 10 is in the same context as claim 2; therefore it is rejected under similar rationale.

Claim 11 is in the same context as claim 3; therefore it is rejected under similar rationale.

Claim 12 is in the same context as claim 4; therefore it is rejected under similar rationale.

Claim 13 is in the same context as claim 1; therefore it is rejected under similar rationale.

Claim 14 is in the same context as claim 2; therefore it is rejected under similar rationale.

Claim 15 is in the same context as claim 3; therefore it is rejected under similar rationale.

Claim 16 is in the same context as claim 4; therefore it is rejected under similar rationale.

Claim 17 is in the same context as claim 5; therefore it is rejected under similar rationale.

Claim 19 is in the same context as claim 7; therefore it is rejected under similar rationale.

Claim 20 is in the same context as claim 8; therefore it is rejected under similar rationale.

In regards to claim 21, Google teaches a method of providing secondary functions from a menu item graphical control, said method comprising: configuring one or more secondary functions to include in a sub-menu (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu, wherein the menu item graphical control further includes one or more graphical components corresponding to one or more programmed functions (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); and displaying the sub-menu in response to a user selecting the sub-menu graphical component (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box.").

Claims 23 and 25 are in the same context as claim 21; therefore they are rejected under similar rationale.

In regards to claim 22, Google teaches a method of providing secondary functions from a menu item graphical control, said method comprising: configuring a plurality of programmed functions using a configuration tool (Page 5, Google Toolbar,

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"Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); identifying a plurality of graphical components for each of the programmed functions (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); displaying the menu item graphical control with the included graphical components (Page 1, Google Toolbar, Elements 1, 2, and 3); receiving a selection from a user corresponding to one of the graphical components (Page 1, Google Toolbar, "Highlight: Highlight your search terms as they appear on the page, each word in its own color"); and invoking the programmed function corresponding the selected graphical component (Page 1, Google Toolbar, "Highlight: Highlight your search terms as they appear on the page, each word in its own color").

Claims 24 and 26 are in the same context as claim 22; therefore they are rejected under similar rationale.



### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-5, 7-17, and 19-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (703) 305-8774. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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